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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,708	07/14/2003	Frank Beerwerth	N98100026/P025	4185

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EXAMINER	
VERBITSKY, GAIL KAPLAN	
ART UNIT	**PAPER NUMBER**
2859	

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/617,708	BEERWERTH ET AL.	
	Examiner	Art Unit	
	Gail Verbitsky	2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 December 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-10 and 12-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4-10,12-19* is/are rejected.

7)☒ Claim(s) *7 and 8* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-2, 4-6, 14-17, 19 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Seacord et al. (U.S. 5167235) [hereinafter Seacord].

Seacord discloses in Figs. 1c, 2, and 5 a device/ protective cap for a temperature-measuring probe introducible in an ear cavity. The cap comprises a base body

(flexible plastic sheath) 16 shaped to fit a tympanic cavity and having an IR transparent window at end 42, the base body 16 also provided with insulation 34. The window is thin (reduced thickness) to be transparent to the IR (col. 5, line 47). Seacord states that the insulation around optical fiber 32 can be a conventional polyethylene (plastic) foam (col. 5, line 29). This would imply, that the insulation would have at least one closed pore (air chamber). It is inherent, that adding pores, and thus, air insulation in the pores, would at least partially improve heat insulation.

For claims 5-6: As shown in Fig. 1c, the insulation 34 is bounded by a flexible film of a flexible (outer) plastic sheath 16. It is inherent, that the at least one air chamber (pore) close to the body cavity (tympanic cavity). Also, the entire surface of the sheath (base) 16 is provided with the thermal insulation 34, as shown in Fig. 1c.

For claim 16: it is inherent that being comprised of a foam and a flexible sheath, the protective cap is not shaped prior to insertion to the ear canal, but only after. Therefore, the cap can expand/ stretch to obtain the necessary shape only when it is inserted into the body cavity, and thus, not prior to being positioned onto the probe.

With respect to the preamble of claims: the preamble of the claims does not provide enough patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and a portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. Kropa v. Robie, 88 USPQ 478 (CCPA 1951).

3. Claims 1, 4-6, 9-10, 12, 17 and 19 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Suszynski et al. (U.S. 5018872) [hereinafter Suszynski].

Suszynski discloses in Figs. 2, 6-7 a device/ protective cap for a temperature-measuring probe; the probe comprising a protective cap constituted by a base body (resilient stretchable film) 43 which is provided with a plastic tube 13, 17 having, as shown in Fig. 7, the protective cap is to be introduced in a body cavity (tympanic cavity). The plastic tube 17 of the cap has a roughened texture to minimize a heat transfer (col. 5, lines 3-16) and thus, serving as an insulation. There are air pockets (chambers) 51, as shown in Fig. 7, formed by the film 43 and the plastic tube/ insulation 17. The air chambers 51 have their outsides close to the body cavity.

The device further comprising a transparent polyethylene IR window 19.

Suszynski also teaches a holding device/ carrier 45 to hold the plastic tube 17 and the film 43, as shown in Fig. 2 and in col. 4, lines 53-57, so as the film is stretched over a window (open end) 19 (col. 4, lines 63-65).

With respect to the preamble of claims: the preamble of the claims does not provide enough patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and a portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. Kropa v. Robie, 88 USPQ 478 (CCPA 1951).

4. Claims 13, 18 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Seacord in view of Bohrn et al. (U.S. 4775586) [hereinafter Bohrn].

Seacord discloses the device as stated above.

Seacord does not teach a hot pressing or hot stamping operation to make the cap, as stated in claims 13, 18.

Bohrn teaches that using a method of hot pressing for a film, a desired transparency to an electromagnetic radiation (including IR) can be obtained.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a method of hot pressing, to provide a transparent window of the device disclosed by Seacord, with a desired transparency, i.e., to IR, as taught by Bohrn, because this method is commonly used to obtain a desired transparency in plastic films.

Allowable Subject Matter

5. Claims 7-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

6. Applicant's arguments with respect to claims 1-2, 4-10, 12-19 have been considered but are moot in view of the new ground(s) of rejection.

With respect to Seacord: Applicant states that Seacord does not disclose a protective cap as recited in the newly amended claim 1, in that the cap of Seacord comprises a disposable sheath 16. Applicant states that the cap of Seacord consists of the sheath 16 and that the insulation of Seacord "has nothing to do with the sheath 16". These arguments are not persuasive because, Seacord teaches all the elements of the cap, as taught by Applicant, including a base (sheath) provided with insulation having air chambers (foam). The fact that the sheath 16 of Seacord is disposable is irrelevant because Applicant does not describe the particular (disposable or non-disposable) cap, etc. Also, the sheath 16 of Seacord is provided (adjacent) with an insulation having at least one air pore/ chamber, as claimed by Applicant.

With respect to Suszynski: Applicant states that Suszynski fails to teach "a probe cover having an air chamber" and "the base body provided with at least one air chamber...". These arguments are not persuasive because: Suszynski teaches a probe cover comprising a foam insulation, which is known to have pore/ air chambers. Suszynski

teaches a base body 43 provided with plastic insulation 17 having air pockets/ air chambers 43, as shown in Fig. 7

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in the PTO-892 and not mentioned above disclose related devices and methods.

Any inquiry concerning this communication should be directed to the Examiner Verbitsky who can be reached at (571) 272-2253 Monday through Friday 8:00 to 4:00 ET.

GKV

Gail Verbitsky
Primary Patent Examiner, TC 2800

March 04, 2005